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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,623	08/28/2003	Yuusaku Ohta	2003_1215A	5299
513 7590 07/10/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER YALEW, FIKREMARIAM A	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 07/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,623	Applicant(s) OHTA ET AL.	
	Examiner Fikremariam Yalew	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/28/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/13/2004, 03/08/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election of claims 1-10,17-20,21-24 in the reply filed on 04/23/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-10,17-20,21-24 have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claims 23 directed to a key supply computer program used in key delivery. The examiner respectfully asserts that the claimed method does not fall within the statutory classes listed in 35 U.S.C 101.Claim 23 is directed to functional descriptive material (i.e., software). Claims 23 is rejected as being functional descriptive material that used in key delivery apparatus.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2,17-24 rejected under 35 U.S.C. 102(e) as being anticipated by Maeda et al (hereinafter referred as Maeda) US 2004/0228487.

8. As per claims 1,21-24: Maeda discloses a key delivery apparatus/system/computer program/computer readable recording medium that manages a decryption key for decrypting an encrypted content and a suppliable number showing how many times the decryption key is suppliable, with respect to a terminal apparatus connected to a network, comprising:

a receiving unit operable to receive, from the terminal apparatus, a supply request for the decryption key(see 0058-0059 and Fig 3 step 14);

a supply judging unit operable, if the terminal apparatus is a legitimate supply target, to judge whether the terminal apparatus is one of a first-type terminal apparatus that manages a content-usage period and a second-type terminal apparatus that does not manage the content-usage period(See Fig 3 step 15 and 0058-0059); and

a key supply unit operable, if the suppliable number has a remaining number, to supply to the terminal apparatus, the decryption key and a key-usage period of the decryption key when judged that the terminal apparatus is the first-type terminal

apparatus and the decryption key when judged that the terminal apparatus is the second-type terminal apparatus(See 0055,0058-0059,0089), wherein the supply judging unit judges the terminal apparatus to be the first-type terminal apparatus if the terminal apparatus records the encrypted content, the decryption key, and the key-usage period onto a portable recording medium(See 0042,0049).

9. As per claim 2: Maeda discloses the key delivery apparatus wherein the network is a home network connected to an external network, contents are received from outside the home network, and the key delivery apparatus judges terminal apparatuses connected to the home network to be legitimate supply targets (See Fig 3 steps 21,1,s4 and 0002,0056).

10. As per claim 17: Maeda discloses portable recording medium that receives supply of a decryption key for decrypting an encrypted content from a key delivery apparatus that manages the decryption key, comprising:

a key reception unit operable to receive the decryption key and a key-usage period of the decryption key from the key delivery apparatus, when judged in the key delivery apparatus that supply of the decryption key is possible(See 0055,0058-0059,0089); and a key-information storage unit operable to store the decryption key and the key-usage period(See 0042,0049)

11. As per claim 18: Maeda discloses the recording medium wherein the key reception unit includes a decryption subunit operable, when the decryption key and the key-usage period of the decryption key are to be received, to receive an encrypted decryption key and an encrypted key-usage period, and to decrypt the encrypted

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decryption key and the encrypted key-usage period to generate the decryption key and the key-usage period (See 0040, 0058-0059,0089).

12. As per claim 19: Maeda discloses the recording medium further comprising: a period judging unit operable to judge whether the key-usage period has expired (See 0089); and a deletion unit operable to delete the decryption key and the key-usage period when judged that the key-usage period has expired (0058-0059,0089).

13. As per claim 20: Maeda discloses the recording medium further comprising: a proprietary judging unit operable to receive, from the key delivery apparatus, search information showing the decryption key, and to judge whether the decryption key is held in the recording medium, using the search information (0058-0059,0089 and Fig 3 step 15); and a proprietary notifying unit operable, when judged that the decryption key is held in the recording medium, to notify to the key delivery apparatus, information indicating that the decryption key is held in the recording medium(0058-0059,0089 and Fig 3 step 15).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Marshall et al(hereinafter referred as Marshall) US Patent No 4,866,707.

16. As per claim 3:Maeda discloses claim 1 as recited above. Maeda does not explicitly teach the key delivery apparatus further comprising: a key-information storage unit operable to store the key-usage period subsequent to supply of the decryption key and the key-usage period to the first-type terminal apparatus; a period judging unit operable to judge whether the key-usage period has expired; and a time management unit operable to add "1" to the suppliable number when judged that the key-usage period has expired.

However Marshall discloses a key-information storage unit operable to store the key-usage period subsequent to supply of the decryption key and the key-usage period to the first-type terminal apparatus (col 7 lines 17-29); a period judging unit operable to judge whether the key-usage period has expired (col 7 lines 17-29); and a time management unit operable to add "1" to the suppliable number when judged that the key-usage period has expired (See col 7 lines 17-29).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the teaching method of Maeda to include key-information storage unit operable to store the key-usage period subsequent to supply of the decryption key and the key-usage period to the first-type terminal apparatus; a period judging unit operable to judge whether the key-usage period has expired; and a time management unit operable to add "1" to the suppliable number when judged that

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the key-usage period has expired . This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, (See Maeda 0009) inorder to prevent the improper usage of contents.

17. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Marshall et al(hereinafter referred as Marshall) US Patent No 4,866,707 and further in view of Mooney et al(hereinafter referred as Mooney) US Patent No 6,351,813 B1.

18. As per claim 4: the combination of Maeda and Marhsall teach claim 3 as recited above. The combination of Maeda and Marshall do not explicitly teach the key delivery further comprising: a date-time storage unit operable to store at least one of a first grouping and a second grouping, the first grouping formed from date-time information showing the key-usage period and a supply date-time of the decryption key, and identification information showing the supply target to be the first-type terminal apparatus, and the second grouping formed from date-time information showing a supply date-time of the decryption key, and identification information showing the supply target to be the second-type terminal apparatus; a date-time judging unit operable to judge whether a present date-time has reached the supply date-time; and a date-time supply unit operable, when judged that the present date-time has reached the supply date-time, to supply the decryption key and the key-usage period to the first-type terminal apparatus or the decryption key to the second-type terminal apparatus, based on the identification information.

However Mooney discloses the key delivery further comprising: a date-time storage unit operable to store at least one of a first grouping and a second grouping, the first grouping formed from date-time information showing the key-usage period and a supply date-time of the decryption key, and identification information showing the supply target to be the first-type terminal apparatus, and the second grouping formed from date-time information showing a supply date-time of the decryption key, and identification information showing the supply target to be the second-type terminal apparatus(See col 10 lines 27-35); a date-time judging unit operable to judge whether a present date-time has reached the supply date-time(See col 10 lines 27-35); and a date-time supply unit operable, when judged that the present date-time has reached the supply date-time, to supply the decryption key and the key-usage period to the first-type terminal apparatus or the decryption key to the second-type terminal apparatus, based on the identification information(See col 10 lines 27-35).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Mooney within the combination of Maeda and Marshall method in order to prevent the improper usage of content.

19. As per claim 5: the combination of Maeda-Marshall-Mooney discloses the key delivery further comprising: a search requesting unit operable to notify, to the first-type terminal apparatus and the second-type terminal apparatus, search information showing the decryption key (See Maeda 0049-0051); and a proprietary information receiving unit operable to receive information indicating that the decryption key is being held, from

whichever of the first-type terminal apparatus and the second-type terminal apparatus holds the decryption key(See Maeda 0039-0041).

20. As per claim 6: the combination of Maeda-Marshall-Mooney discloses the key delivery apparatus wherein the key delivery apparatus stores secret information used as a reference in judging whether the terminal apparatus is a legitimate supply target, the supply judging unit includes an authentication subunit operable to judge whether the terminal apparatus holds the secret information, and the supply judging unit judges the terminal apparatus to be a legitimate supply target when judged that the terminal apparatus holds the secret information(See Maeda Fig 3 step 15 and 0058-0059).

21. As per claim 7: the combination of Maeda-Marshall-Mooney discloses the key wherein the key supply unit includes a remaining number judging subunit operable to judge whether the suppliable number is greater than a predetermined reference number, and the key supply unit judges the suppliable number to have the remaining number when judged that the suppliable number is greater than the predetermined reference number (See Maeda Fig 4 steps 1001,1002, Fig 5 steps 2000-2002).

22. As per claim 8: the combination of Maeda-Marshall-Mooney discloses the key delivery apparatus wherein the key supply unit further includes an encryption subunit operable to encrypt the decryption key and the key-usage period when the decryption key and the key-usage period are to be supplied to the first-type terminal apparatus, and to encrypt the decryption key when the decryption key is to be supplied to the second-type terminal apparatus, and the key supply unit, when judged that the suppliable number has the remaining number, supplies to the terminal apparatus, the

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encrypted decryption key and the encrypted key-usage period when judged that the terminal apparatus is the first-type terminal apparatus and the encrypted decryption key when judged that the terminal apparatus is the second-type terminal apparatus(See Maeda 0055,0058-0059,0089).

23. As per claim 9: the combination of Maeda-Marshall-Mooney disclose the key delivery apparatus further comprising: a historical information storage unit operable to store historical information showing a connection date-time of the first-type terminal apparatus (See Marshall col 7 lines 17-2); a connection judging unit operable to judge, using the connection date-time, whether the first-type terminal apparatus was connected within a predetermined connection period(See Marshall col 7 lines 17-2); and a connection management unit operable to add "1" to the suppliable number when judged that the first-type terminal apparatus was not connected within the connection period(See Marshall col 7 lines 17-2).

24. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (hereinafter referred as Maeda) US 2004/0228487 in view of Marshall et al(hereinafter referred as Marshall) US Patent No 4,866,707 and further in view of Mooney et al(hereinafter referred as Mooney) US Patent No 6,351,813 B1.

25. As per claim 10: the combination of Maeda-Marshall-Mooney disclose claim 8 as recited above. The combination of Maeda-Marshall-Mooney do not explicitly disclose the key delivery apparatus further comprising: a frequency storage unit operable to store a usage frequency of the decryption key by the first-type terminal apparatus; a frequency judging unit operable to judge whether the usage frequency has reached a

predetermined reference frequency; and a connection management unit operable to add "1" to the suppliable number when judged that the usage frequency has reached the reference frequency.

However Hamada discloses the key delivery apparatus further comprising: a frequency storage unit operable to store a usage frequency of the decryption key by the first-type terminal apparatus(See 0020,0028); a frequency judging unit operable to judge whether the usage frequency has reached a predetermined reference frequency; and a connection management unit operable to add "1" to the suppliable number when judged that the usage frequency has reached the reference frequency(See 0020,0028).

Therefore it would have been obvious to one ordinary skill in the art at the time the invention was made to employ the teaching method of Hamada within the combination of Maeda and Marshall-Moony method inorder to protect a copy right for a content provider when the content data is moved or paused (See Hamada 0011)

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fikremariam Yalew whose telephone number is 5712723852. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser can be reached on 571-272-4195. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fikremariam Yalew
06/28/2006
FA

Art Unit 2136

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6,29,07